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Thomas L. Evans**COMPANY:**
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May 18, 2006**FAX NUMBER:**
(571) 273-8300**TOTAL NO. OF PAGES (INCLUDING COVER SHEET):**
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Application No.: 10/086,644**OUR REFERENCE (C/M) No.:**
Atty. Docket No.: 005127.00197**RE:**
Amended Appeal Brief*If you do not receive all page(s) or have any problems receiving this transmission, please call:***NAME:** Thomas L. Evans Reg. # 35,805 **PHONE:** (503) 425-6800**COMMENTS:**

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/086,644	
	Filing Date	February 28, 2002	
	First Named Inventor	Allan M. Schrock, et al.	
	Art Unit	2859	
	Examiner Name	Thanh S. Phan	
Total Number of Pages in This Submission	11	Attorney Docket Number	005127.00197

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Thomas L. Evans, Reg. No. 35, 805		
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Date	May 18, 2006		

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In re Application for:

Allan M. SCHROCK et al.

Application No.: 10/086,644

Filed: February 28, 2002

For: PACE CALCULATION WATCH

Examiner: Thanh S. Phan
Art Group: 2859

Attorney Docket No.: 005127.00197


MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450AMENDED APPEAL BRIEF

Sir:

In response to the Order Returning Undocketed Appeal To Examiner mailed on May 2, 2006, Applicants respectfully submit this Amended Appeal Brief for the above identified application.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Date: May 18, 20061001 G Street N.W., 11th Floor
Washington, D.C. 20001-4597
(503) 425-6800
Thomas L. Evans
Registration No. 35,805

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MAY 18 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES*In re* Application of)

Allan M. SCHROCK ET AL.)

Serial Number 10/086,644)

Filed: February 28, 2002)

For: PACE CALCULATION WATCH)

Group Art Unit: 2859

Examiner: Thanh S. Phan

Attorney Reference: 005127.00197

REPLY BRIEFCommissioner for Patents
U.S. Patent and Trademark Office
Alexandria, VA 22313

Sir:

In response to the Examiner's Answer, mailed June 30, 2005, Appellants respectfully submit this Reply Brief in the above-captioned appeal to the Board of Patent Appeals and Interferences.

Grounds Of Rejection To Be Reviewed On Appeal

The following grounds of rejection have been presented to the Board of Patent Appeals and Interferences for review in this appeal:

- (a) Claims 1-8, 10-14, 16-29, 31-43 and 45-51 have been rejected under 35 U.S.C. §103 over U.S. Patent No. 5,050,141 to Thinesen in view of U.S. Patent No. 5,526,290 to Kanzaki.

(b) Claims 9, 15, 30 and 44 have been rejected under 35 U.S.C. §103 over U.S. Patent No. 5,050,141 to Thinesen in view of U.S. Patent No. 5,526,290 to Kanzaki, in further view of U.S. Patent No. 5,771,399 to Fishman

Arguments

The Primary Examiner maintained the rejection of claims 1-8, 10-14, 16-29, 31-43 and 45-51 under 35 U.S.C. §103 over U.S. Patent No. 5,050,141 to Thinesen in view of U.S. Patent No. 5,526,290 to Kanzaki. Appellants again respectfully traverse this rejection, and courteously ask for its withdrawal.

Each of claims 1-51 recites the determination of a pace by dividing a distance stored in memory by an elapsed time or a segment of an elapsed time. As described in the specification, the elapsed time is a time period that has already occurred. It is not a predicted or future time period. Thus, as explained in detail in the Appeal Brief, no combination of the Thinesen and Kanzaki patents would teach or suggest the specific devices and methods for determining a pace recited in the rejected claims.

Appellants respectfully submit that the Primary Examiner's reliance on the Thinesen and Kanzaki patents is based upon a misunderstanding of their disclosures. For example, in the Examiner's Answer, the Primary Examiner stated:

Kanzaki teaches determining a pace by initiating a stop watch, timing the duration of time that it takes for a runner to run a distance X and setting the pace therefrom, see Kanzaki column 6, line 53 - column 7, line 8. (See Examiner's Answer, page 7, lines 15-17.)

To demonstrate how the Primary Examiner has misinterpreted the Kanzaki and Thinesen patents, this portion of the Kanzaki patent is reproduced in its entirety below:

In the test run mode, a pace in the first mode test run is set and a test run time in which the runner runs any distance x at the pace is measured (step A3).

The runner keys in pace data by the fourth key switch S4 to set the pace. As shown in the first test run picture B of FIG. 3, *the pace is set, for example, at 190 steps/minute*. The pace data P1 is stored in the first pace P1 memory area 5e of the RAM 5 of FIG. 2. The CPU 3 outputs a pace signal to the amplifier 6 on the basis of the pace data and the speaker 7 generates a signal sound at periods of 190 steps/minute.

As shown in FIG. 5, the runner runs a course X having any distance x *at a pace corresponding to the signal sound*. At the start of the course X, the runner depresses the fifth key switch S5 to start the stopwatch function and starts to run the course to the signal sound. The runner then stops the stopwatch function by depression of the fifth key switch S5 again at the end point of the course X to measure the test run time for the course X. The test run time data obtained in this measurement is stored in the first test run time T1 area 5f of the RAM 5. Assume now that the first run time taken is 21 seconds. (See Kanzaki, column 6, line 53 - column 7, line 8, *emphasis added*.)

If they show nothing else, the emphasized language clearly establishes that this portion of the Kanzaki patent does not teach or suggest determining a pace, as argued by the Primary Examiner.

Instead, this portion of the Kanzaki patent specifically describes having the user enter a predetermined pace. A CPU then outputs a signal corresponding to the *pace input by the user*. Thus, if the user inputs a pace of 2 mph, this is the pace information stored in the Kanzaki system, regardless of the actual pace, faster or slower, subsequently run by the user. While the Kanzaki patent does teach calculating a pace, it does not do so in the text relied upon by the Primary Examiner. Moreover, Kanzaki's methods of calculating a pace still would not teach or suggest the method and devices recited in the rejected claims, as discussed in detail by Appellants' Appeal Brief from page 3, line 27 to page 4, line 5.

The Primary Examiner's misunderstanding of the Kanzaki and Thinesen patents is further revealed by the alleged "motivation" provided to support the combination of their teachings. As

previously noted in Appellants' Appeal Brief, the Kanzaki patent is directed to a technique for discovering the pace at which a runner ideally should run. The Thinesen patent, on the other hand, is directed to a device for synchronizing a pace produced by the device with the user's actual pace. Thus, not only would the Primary Examiner's combination of the Thinesen and Kanzaki patents fail to teach the features of the invention, it would vitiate the very teachings of the Thinesen patent.

Notably, the Primary Examiner did not reply to this apparent discrepancy with a more thorough explanation of the motivation upon which the combination was predicated. The Primary Examiner instead addressed the question of motivation as follows:

In this case, a skilled artisan would have been motivated to combine the pace determine technique of Kanzaki with the pace synchronization device of Thinesen in order to obtained pace calculation necessary *to display or set* a pace. (See Examiner's Answer, page 8, lines 13-16, *emphasis added*.)

This motivation is not supported, however, by the teachings of the Kanzaki and Thinesen patents. Moreover, the Primary Examiner has not explained why the Kanzaki and Thinesen patents would be combined to provide a device that either displays or sets a pace, as each of the Kanzaki and Thinesen devices appear to provide both of these features. See, e.g., the Kanzaki patent, column 5, lines 30-32 ("...a display driver 8 and a display 9 which cooperate to display the time, pace...") and column 6, lines 56-56 ("[t]he runner keys in pace data...to set the pace..."). See, e.g., the Thinesen patent, column 2, lines 11-14 ("...one object of the present inventions [sic] is to allow...the operator to synchronize the pace which is set in a multimode alarm timepiece...") and column 8, lines 34-35 ("...and the display is updated to show the new pace..."). Appellants can therefore only conclude that the asserted combination of the Thinesen and Kanzaki patents is based upon a fundamental misinterpretation of the disclosures in these patents.

Accordingly, Appellants again submit that one of ordinary skill in the art would not have been led to combine the Thinesen and Kanzaki patents in the manner proposed by the Primary Examiner, and, further, that no combination of the Thinesen and Kanzaki patents would teach or suggested the invention as recited in any of claims 1-51. Appellants therefore again request that the rejection of claims 1-8, 10-14, 16-29, 31-43 and 45-51 under 35 U.S.C. §103 over U.S.

Patent No. 5,050,141 to Thinesen in view of U.S. Patent No. 5,526,290 to Kanzaki be reversed.

The Primary Examiner also rejected claims 9, 15, 30 and 44 over the combination of the Thinesen and Kanzaki patents, in further view of U.S. Patent No. 5,771,399 to Fishman. As explained in detail above one of ordinary skill in the art would not have been led to combine the Thinesen and Kanzaki patents in the manner suggested by the Primary Examiner. Further, no combination of the Thinesen and Kanzaki patents would teach or suggest the invention as recited in any of claims 1-51. It is respectfully submitted that the Fishman patent does not remedy the omissions of the Thinesen and Kanzaki patents. Appellants therefore ask that the rejection of claims 1-51 be reversed as well.

Conclusion

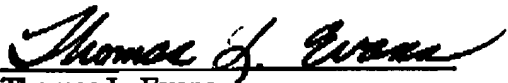
In view of the foregoing arguments and those presented in Appellants' earlier Appeal Brief, Appellants again respectfully ask that the rejections submitted in the final Office Action of August 13, 2004 be reversed for at least the reasons recited above. Allowance of claims 1-51 is, therefore, respectfully requested.

A Request For Oral Hearing is being concurrently submitted with this Reply Brief. The Commissioner is authorized to charge the fees associated with that Request, together with any

other fees that may be necessary to maintain the pendency of either this application or the related appeal, to Deposit Account No. 19-0733.

Favorable action is courteously requested at the Board's earliest convenience.

Respectfully submitted,

By: 
Thomas L. Evans
Registration No. 35,805

Banner & Witcoff, Ltd.
1001 G Street, N.W.
Washington, D.C. 20001-4597
Telephone: (202) 824-3000

Dated: May 18, 2006

Evidence Appendix

n/a

Related Proceedings Appendix

n/a